

REMARKS

Claims 9 to 16 are presently pending in this application. All of the claims stand rejected. Claims 9, 12, 15, and 16 have been amended. All of the amendments find full support in the specification and drawings as filed. No new matter has been added. Entry of these amendments is respectfully requested.

In view of the above amendments and the following remarks, Applicants respectfully submit that this application is in condition for allowance. Accordingly, reconsideration and a timely indication of allowance are respectfully requested.

Objections to the Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. Regarding claims 9 to 16, the Examiner states that a first section with a bottom wall, a pair of opposed sidewalls, a front wall, and a rear wall is not described in the specification. A second section with a bottom wall, a pair of opposed sidewalls, a front wall, and a rear wall is not described in the specification.

Applicants have amended claims 9, 12, 15 and 16 to remove the portion of the claim requiring a second section with a pair of opposed sidewalls. Applicants respectfully submit that Fig. 2, as filed, shows a second section with a bottom wall, a front wall, and a rear wall. Accordingly, Applicant respectfully submits that all of the remaining claim limitations find full support in the specification and drawings as filed.

Therefore, Applicants respectfully submit that the objections to the specification have been obviated.

Objections to the Drawings

The Examiner objected to the drawings as failing to show a second section with a pair of opposed side walls as recited in claims 9, 12, 15, and 16. As explained above, Applicants have amended claims 9, 12, 15 and 16 to remove the portions of the claims requiring a second section with a pair of opposed sidewalls.

Accordingly, Applicants respectfully submit that the objections to the drawings have been obviated and no submission of corrected drawing sheets is necessary.

Rejections Under 35 U.S.C. § 112

Claims 9 to 16 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, with regard to claims 9, 12, 15 and 16, the Examiner states that assuming the second section refers to the lower compartment (46) it is unclear how the second section has a pair of opposed side walls since from the drawing it appears to be an elliptical shape and the specification is silent as to walls of each compartment and only discusses the walls of the whole pencil case.

Applicants have amended claims 9, 12, 15 and 16 to remove the recitation of opposed side walls in the second section. Applicants respectfully submit that all of claims 9 to 16 as amended comply with the written description requirement.

Accordingly, Applicants respectfully request that the rejection of claims 9 to 16 under 35 U.S.C. § 112, first paragraph, be withdrawn.

Claims 9 to 14 are rejected under 35 U.S.C.

§ 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, with regard to claims 9 and 12, the Examiner states that there is insufficient antecedent basis for the limitation "the bottom wall of the pencil case."

Applicants have amended claims 9 and 12 to change "the bottom wall of the pencil case" to "the bottom wall of the first section." Applicants respectfully submit that proper antecedent basis is found for "the bottom wall of the first section." Full support for this amendment is found in the specification and drawings as filed, for example, in Fig. 2. No new matter has been added. Entry of this amendment is respectfully requested.

Accordingly, Applicants respectfully request that the rejection of claims 9 to 14 under 35 U.S.C. § 112, second paragraph, be withdrawn.

Rejections Under 35 U.S.C. § 103

Claims 9 to 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Barecki et al. (U.S. Pat. No. 3,758,182) in view of Lundahl (U.S. Pat. No. 2,535,743) and Rapp-Duncan (U.S. Pat. No. 6,056,178). Applicants respectfully traverse this rejection.

The invention as presently claimed solves the long-standing problem of how to provide a pencil tray to student desks having a wire mesh book rack. Applicants respectfully submit that the Examiner fails to make a *prima facie* case for obviousness against claims 9 to 16. Moreover, even if the examiner provided a *prima facie* case of evidence, the invention was not made obvious by the combination of references cited in support of the rejections under 35 U.S.C. § 103.

The examiner's position fails to make a *prima facie* case for obviousness, because each of claims 9 to 14, as amended, require a "pencil case attachment plate attached to the bottom walls of the pencil case such that a portion of the bottom wall of the book rack is sandwiched between the pencil case attachment plate and the bottom wall of the first section." Nowhere in the references is there disclosed or fairly suggested any such "pencil case attachment plate attached to the bottom walls of the first section and the second section such that a portion of the bottom wall of the book rack is sandwiched between the pencil case attachment plate and the bottom wall of the first section ." Accordingly, for this first reason, the rejection of claims 9-14 under 35 U.S.C. § 103 is in error and should be withdrawn.

Secondly, each of claims 9-16 require that the second section of the pencil case disposed at an elevation lower than the bottom wall of the first section has "a bottom wall, a front wall and a rear wall." Nothing in the references currently cited in support of the rejections under 35 U.S.C. § 103 discloses or fairly suggests a pencil case having such a configuration. Thus, for this additional reason, the cited references do not make out a *prima facie* case of obviousness. Accordingly, for this second reason, the rejections of claims 9-16 under 35 U.S.C. § 103 is inappropriate and should be withdrawn.

Finally, even if the cited references provided a *prima facie* case of obviousness against claims 9-16, the rejection of claims 9-16 under 35 U.S.C. § 103 would be in error. There is nothing in these three references -- or in any of the other references cited in this application -- that would make obvious the piecemeal combination of various components of the devices disclosed in the three cited references in such a way as to achieve the invention.

As stated in MPEP §2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Barecki et al. merely recites the prior use of student desks having a wire mesh book rack. Barecki et al. teaches away from the invention by teaching the use of a pencil tray in the cited desk only as a replacement for the wire mesh book rack. Thus, Barecki et al. emphasizes the prior belief among those of ordinary skill in the art that the use of a pencil case in combination with a wire mesh book rack was not possible, or least not practical.

The Lundahl reference discloses an accessory tray for small items such as paper clips, pins, erasers, pencils and the like. However, Applicants respectfully submit that one skilled in the art would have no motivation to attach Lundahl's accessory tray to a wire book rack, because Lundahl's accessory tray is specifically configured to be attached to a typewriter or adding machine. As explained in col. 1, lines 21 to 29 of Lundahl,

"novelty is predicated upon a tray having an apron-like flange, the same carrying an outstanding, horizontally disposed sheath and said sheath having a slide mounted therein, the sheath and slide being such that they may be relatively adjusted and then fastened in between the basal portion of the typewriter frame and the usual pads or supporting feet with which typewriters are provided."

Moreover, with regard to claims 11 and 14, the Examiner proposes modifying the Lundahl reference to remove the flange. Surely, removal of the main point of novelty impermissibly changes the principal of operation of Lundahl. There is nothing in Barecki et al. or Lundahl which would suggest or give incentive to those of ordinary skill in the art to combine the teachings of Lundahl and Barecki et al. for any reason.

The Rapp-Duncan reference teaches the attachment of a wire mesh bin to a wire mesh shopping cart. Rapp-Duncan is neither addressed to student desks or to pencil trays. Moreover, the wire mesh bin itself is attached to a first frame fastening bar 60, which is then attached through the wire mesh of the shopping cart to a second frame fastening bar 70. If, as proposed by the Examiner, a pencil case is attached to a wire book rack in the manner taught by Rapp-Duncan, then the bottom wall of the book rack would not be "sandwiched between the pencil case attachment plate and the bottom wall of the first section" as required by claims 9 to 14.

Rather, the bottom wall of the first section would be fastened to a first fastening bar, and the bottom wall of the book rack would be sandwiched between the first fastening bar and a second fastening bar. Removal of the first fastening bar would impermissibly change the principle of operation of Rapp-Duncan, because without the first fastening bar the wire mesh bin would not be attachable to the wire mesh of the shopping cart.

Finally, there is nothing in the three references, Barecki et al., Lundahl and Rapp-Duncan, which would suggest to those of ordinary skill in the art by a three-way combination of these references or otherwise give incentive to those of ordinary skill in the art to somehow construct a pencil case as claimed in the application and attach it to the wire mesh book rack disclosed in Barecki et al. Any attempted reconstruction of the invention based on a three-way combination of Barecki et al., Lundahl and Rapp-Duncan would require impermissible hindsight and piecemeal reconstruction. Accordingly, for this third reason, the rejection of claims 9-16 under 35 U.S.C. § 103 is in error and should be withdrawn.

CONCLUSION

For the reasons set forth above, applicant respectfully submits that all of the claims remaining in the application are now in condition for allowance. Accordingly, reconsideration, reexamination and allowance of all claims is requested.

If there remain any issues that can be addressed by telephone, the Examiner is encouraged to contact the undersigned.

No fees are believed due with this Amendment. However, the commissioner is hereby authorized to deduct any and all fees associated with this communication to Deposit Account No. 19-2090.

Respectfully submitted,

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